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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,230	03/28/2001	Donald J. Palmer	10003979-1	4597

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 HEWLETT-PACKARD COMPANY
 Intellectual Property Administration
 P.O. Box 272400
 Fort Collins, CO 80527-2400

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,230

Applicant(s)

PALMER ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-22 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-22 and 24-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 April 2005 has been entered.

Response to Arguments

2. Applicant's arguments filed with an amendment on 8 April 2005 have been fully considered but they are not convincing. The arguments have been addressed by revision of the last rejection, and by discussion at para. 6, 9 and 10 below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 11-22 and 24-31 are rejected under 35 U.S.C. 103(a) as being obvious over DeLorme et al. (US005948040A) in view of Ogasawara (US006513015B2).
5. DeLorme et al. teaches (independent claims 1, 16, 24 and 26) a method of providing information to a consumer and marketing an information database, an information system, and a computer readable medium having instructions for performing said method, the method comprising: receiving a request for first *travel* information from the consumer (col. 6 lines 58-59) to (at) an information station, the **PC 105** (col. 13 line 37), that is located external to, and separate from a retailer (see para. 6 below); retrieving the first information and a first incentive (*coupon*) related to the first information (col. 12 lines 38-45) from an information database system, and printing the first information and incentive on an

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- information page for the consumer at the information station (col. 18 lines 25-34). DeLorme et al. also teaches (claim 24) identifying a consumer by account number (col. 37 lines 3-14).
6. DeLorme et al. teaches that the information station is a *personal computer 105* (col. 13 line 37). That description and Fig. 1A make clear that said information station is located at the consumer's home, and therefore external to, and separate from a retailer. Applicant argues (last para. on p. 9) that the second reference (Ogasawara) fails to teach this limitation. Of course it does not have to, because the first reference does teach this limitation.
7. DeLorme et al. also teaches restaurant coupons (col. 12 line 42) but does not teach submitting, via the retailer, data identifying the first information and the first incentive after use of the incentive by the first unique consumer at the retailer. Because it is common and efficient to process coupons through specialized clearing houses, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of DeLorme et al. submitting, to the clearinghouse, via the retailer (the restaurant) data identifying the first information (the identity of the restaurant in said travel information) and the first incentive (the coupon) after use of the incentive by the first unique consumer at the retailer.
8. DeLorme et al. does not teach: a customer parameter database; selecting the first information and incentive via user preference criteria from said customer parameter database; submitting said coupon data to update the user preference criteria; and selecting a second information and a second incentive, based on the updated user preference criteria, upon a second request by the consumer. Ogasawara teaches a customer parameter database (*customer data record*, col. 4 lines 1-8); making personalized recommendations of items for purchase and promotions, based on the customer parameter database/*customer data record* (col. 5 lines 17-33), which reads on selecting the first information and incentive via user preference criteria from said customer parameter database; maintaining an updated transaction record (col. 2 lines 16-17), which reads on submitting, via the retailer, data identifying the first information and incentive, after use of the incentive, to update the user preference criteria; and, upon the next visit to a retailer, again making personalized recommendations of items for purchase and promotions, based on the customer parameter database/*customer data record* (col. 5 lines 17-33), which reads on selecting a second information and a second incentive, based on the updated user preference criteria, upon a

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second request by the consumer. Because Ogasawara teaches special applicability to hotels and restaurants (col. 6 line 9) and coordinated item recommendations (col. 5 lines 31-32), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Ogasawara to those of DeLorme et al.

9. Applicant argues (p. 10) that the references cannot be reasonably combined because Ogasawara is "directed to relatively aggressive sales situations" and "identifying a customer as the customer enters a particular commercial establishment (e.g., ... hotel, restaurant, ...)". Applicant's characterization of Ogasawara is correct, but largely irrelevant. The references are properly combinable principally because Ogasawara teaches special applicability to hotels and restaurants. See the last four lines of para. 8 above.
10. That Ogasawara teaches aggressive sales tactics is hardly reason why it cannot be combined with De Lorme et al. There is nothing about De Lorme et al. that is incompatible with aggressive methods. The Ogasawara teaching of identifying customers as they enter the door complements the De Lorme teaching of customer identification by voluntary, but encouraged, registration (col. 31 lines 60-65).
11. DeLorme et al. also teaches at the citations given above claims 3, 11-15, 17, 18, 21, 22 and 28.
12. DeLorme et al. also teaches: claims 2, 5, 19, 20 and 27 (col. 21 lines 7-48 and col. 51 line 11); 29-34); claims 4, 6, 7 and 29 (col. 59 lines 29-34, and Fig. 5D for claim 29); claim 8 (col. 59 lines 29-34, col. 11 lines 18-24 and col. 12 lines 58-61 [Fig. 1C]); claim 9 (col. 34 lines 27-31); and claim 25 (col. 67 lines 32-39).
13. Ogasawara also teaches at the citations given above claims 30 and 31.

Conclusion

14. This is a continuation of applicant's earlier Application No. 09819230. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
17. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
19. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues,

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or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

20. Applicant may have after final arguments considered and amendments entered by filing an RCE. However, while the examiner would be pleased to receive another RCE, the examiner is compelled to note that this application appears to have no real promise of being patented by further prosecution. Should applicant choose to pursue this application further, the examiner suggests an appeal to the Board as the only avenue offering even remote promise.
21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

30 July 2005

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
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